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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,193	07/28/2000	Glennis J. Orloff	A0000001-04-CWA	3154

7590

12/21/2004

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/626,193	<b>Applicant(s)</b> ORLOFF ET AL.	
	<b>Examiner</b> Boyer D. Ashley	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 and 67-118 is/are pending in the application.
- 4a) Of the above claim(s) 1-63, 70-84 and 88-115 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64, 67-69, 85-87 and 116-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. \* See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

1. This office action is in response to applicant's amendment filed 10/12/04, wherein claim 64 was amended; and claims 116-118 were added.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 64, 67, and 86-87 are rejected under 35 U.S.C. 102(b) as being anticipated by Sturtevant et al., U.S. Patent 5,100,506, as set forth paragraph 3 of the office action dated 7/8/04.

As to claim 116, Sturtevant discloses the same invention as claimed including, e.g., the substrate has a generally flat upper surface as shown in Figure 5; a blade support (59) attached to the substrate and extending above the surface of the substrate, and a blade with a cutting edge (57, the outer edge) attached to the blade support elevated above the surface of the substrate, wherein the cutting edge is capable of cutting hair.

It should be noted that the specific language "the micro-blades are configured for cutting hair when drawn across a skin surface and without damaging the skin" is merely functional/intended use recitations not defining any specific structure. In apparatus claims functional/intended use language does not serve to distinguish the claimed invention from the prior art; apparatus claims must be define over the prior art in terms

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of structure. The only requirement is that the prior art be capable of the functional/intended use. In this case the prior art is fully capable of cutting hair not matter how poorly it may or may not perform. There is no requirement for a prior art reference to function perfectly.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturtevant as set forth in paragraph 5 of office action dated 7/8/04.

6. Claim 85 is rejected under 35 U.S.C. 102(b) as anticipated by Sturtevant or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sturtevant as set forth in paragraph 6 of office action dated 7/8/04.

7. Claims 116-118 are rejected under 35 U.S.C. 102(b) as anticipated by Sturtevant or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sturtevant.

As to claim 116, Sturtevant discloses the same invention as claimed including, e.g., the substrate has a generally flat upper surface as shown in Figure 5; a blade support (59) attached to the substrate and extending above the surface of the substrate, and a blade with a cutting edge (57, the outer edge) attached to the blade support elevated above the surface of the substrate, wherein the cutting edge is capable of cutting hair.

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In the alternative, even if it is argued that Sturtevant lacks separately pieced together elements for the substrate, blade support, and blade because said three elements are integral, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use separate blade supports for each blade in order to save time and money replacing individual blades, because it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

As to claim 117, the blade support portion extends from the portion (59) to just before the cutting edge portion (57) and therefore is generally perpendicular to the upper surface of the substrate as it extends upperly relative to the substrate.

As to claim 118, cutting edge is generally parallel to the upper surface considering the cutting edge extends around the outer edge; moreover, column 6, lines 25-35 discloses that the cutting edge could take on different sizes and shapes, such as rounded, serrated, pointed, and etc. Therefore, the cutting edges can be generally parallel to the upper surface of the substrate.

It should be noted that the specific language "adapted in size and shape and oriented relative to the upper surface to cut hair when drawn across a skin surface and without damaging the skin surface" is merely functional/intended use recitations not defining any specific structure. In apparatus claims functional/intended use language does not serve to distinguish the claimed invention from the prior art; apparatus claims must be define over the prior art in terms of structure. The only requirement is that the prior art be capable of the functional/intended use. In this case the prior art is fully

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capable of cutting hair not matter how poorly it may or may not perform. There is no requirement for a prior art reference to function perfectly.

***Response to Arguments***

8. Applicant's arguments filed 10/12/04 have been fully considered but they are not persuasive.

Applicant contends that Sturtevant's device is not configured for hair removal as typically understood by those skilled in the art of shaving and razors. Although, it is true that Sturtevant's device was not original intended to be used as a hair removal it nonetheless is fully capable of removing hair. Please see additional comments above in the rejections. It should also be noted that 100's of micro blades extending from a substrate may not be typically understood by those skill in the art of shaving and razors as a hair removing device. It should further be noted that the "configured to" language does no impart any particular structure.

Applicant contends that Sturtevant's device may damage the skin of the user; however, it should be noted that there is no requirement for the prior art to function perfectly or to be flawless. Even if it is true that Sturtevant's device would damage the skin of the user it nonetheless will remove skin.

Applicant contends that Sturtevant lacks the blades mounted on separate blade supports; however, it should be noted the language of claim 85 does not require any specific additional structure only that each blade is separately mounted. As in the Figures each of the cutting edges on mounted to the substrate separately. The examiner was not admitting anything with rejection of claim 85 only suggesting the

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alternative that one could use additional structure, which is not required in the claim, to mounted the cutting edges whether the device of Sturtevant is etched or not.

9. For the reasons above, the grounds of rejection are deemed proper.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
December 15, 2004